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09/991,379	11/15/2001	John Joseph Mascavage III	020375-002710US	2669

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EXAMINER

CHENCINSKI, SIEGFRIED E

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3695

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08/16/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/991,379	Applicant(s) MASCavage ET AL.	
	Examiner SIEGFRIED E. CHENCINSKI	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/20/08, 6/30/10</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

1. Claims 1-12 and 14-20 are pending.

Claim 13 has been canceled.

Applicant filed an RCE within 60 days of the mailing of a decision by the Board of Patent Appeals and Interferences which affirmed the examiner's rejection of claims 1-12 and 14-20, and reversed the examiner on the rejection of dependent claim 13.

Applicant has incorporated claim 13 into independent claims 1, 10 and 17 by amendment.

Claim Objections

2. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 5 has the same limitation as the subject matter incorporated into independent claims 1 on which the claim depends, namely "wherein the receiving transaction information step triggers the opening the equivalent of a pop-up window step".

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9-12, 14, 15 & 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilf et al (US Patent 5,899,980, hereafter Wilf) in view of Stein et al. (US Patent 5,826,241, assigned to PayPal, hereafter Stein), Paltenghe et al. (PreGrant

Publication 2002/0004783 A1, hereafter Paltenghe), Daniels et al. (US Patent 5,758,126, hereafter Daniels), Matyas, Jr. (US Patent 6,102,287, hereafter Matyas), and Applicant Admitted Prior Art (hereafter AAPA).

Re. Claim 1, Wilf discloses a method for authorizing and checking out from an online purchase between a customer and a vendor site/merchant system, the method comprising steps of:

- from the funds transfer server, interacting with the customer's computer to receive a transaction amount (Wilf calls the "transaction amount" the "transaction sum".) through an interface and receive customer assent to the transaction amount. (The term "transaction detail" is an integral component of Wilf's preferred term "transaction data" for approval by the customer/user. Wilf uses this term throughout the reference. Examples are Col. 2, lines 30, 35, 37 and following throughout the reference. Wilf provides specific definition to the effect that a "transaction amount" is a component of this "transaction detail" as illustrated in the following locations: Col. 1, lines 27-28 and Col. 9, lines 24-29).
- receiving authorization from the customer for billing of the transaction sum, wherein the transaction sum corresponds to the online purchase; and notifying the vendor site of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose

- at a funds transaction server, receiving transaction information from the vendor site, wherein the transaction information comprises a transaction amount;
- opening a pop-up window for the customer; wherein the receiving transaction information step triggers the opening the equivalent of a pop-up window step;
- from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window.

However, Paltenghe discloses at a funds transaction server (the wallet server), receiving transaction information from the vendor site, wherein the transaction information comprises a transaction amount (implicitly included in the invoice information (pp. 6-7, [0071], ll. 3-11, 12-15, 19-22, 29-31)).

Also, Stein discloses the presenting of the transfer amount through an internet interface (Col. 7, l. 58 – Col. 8, l. 18). The ordinary practitioner of the art would have seen it as obvious at the time of Applicant's invention that a web browser window was a practical and popular interface for displaying this transaction data for the customer buyer's authorization or rejection of the payment by transfer. Stein also discloses the use of a debit for making payment for a transaction performed over the internet as payment for the internet purchase's transaction amount (Col. 10, l. 51).

Further, Daniels discloses a definition for pop-up windows as windows 'which open or "pop-up" when a display button is actuated' (Col. 13, ll. 58-60).

In addition, Matyas discloses the use of pop-up windows in order to achieve a task in a payment process (Col. 12, l. 41, 46-49).

Finally, Applicant admits in his argument that the term "pop-up window" was "notoriously well known" at the time of this parent application's filing date (Appeal Brief, page 4, l. 19; p. 8, l. 6). Applicant also admits in his Reply Brief received on July 27, 2005 that "pop-up window is synonymous with a new web browser window, automatically opened and viewable by the customer" (p. 4, ll. 1-3). This argument is convincing as it records Applicant's admission of the "automatically opening a new web browser window for the customer" as Appellant admitted prior art (AAPA), since pop-up windows were an obvious and even ubiquitous automatic phenomenon experienced by millions of web browser users at the time of Applicant's invention.

Regarding "wherein the receiving transaction information step triggers the opening the equivalent of a pop-up window step":

a) Matyas and disclose extensive and broad information for the use of pop-up windows as follows:

MATYAS:

Detailed Description Text - DETX (105):

The plug-in content in the HTML page (to be viewed) references a Multipurpose Internet Mail Extensions (MIME) file type that must be supported by a specific plug-in, in order for the content to be displayed/viewed. When the Netscape Navigator (browser), or any compatible browser, encounters the

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<EMBED> tag, the browser verifies that the required plug-in, needed to display the content corresponding to that <EMBED> tag, has been installed. If so, then the browser will invoke the plug-in to view/display the MIME content corresponding to the EMBED tag. Otherwise, the Netscape Navigator (browser), opens a **pop-up** window, which will allow the user to download and install the required plug-in. Once the plug-in has been installed, it can be reused repeatedly without downloading it each time.

Detailed Description Text - DETX (106):

Using the information contained in the <EMBED> tag, the MiniPay plug-in displays a **pop-up** window with all the necessary information to permit the user to initiate a MiniPay payment order. An understanding of these steps is not important to the present invention. (Col. 12, ll. 32-50).

DANIELS

Detailed Description Text - DETX (38):

The next functional module is display support module 357. Display support module 357 provides visual feedback devices which enable a user client 30 to better utilize electronic forms application 35. Electronic forms application 35 may include any of a number of visual feedback devices, for example, **pop-up** windows and grid displays. **Pop-up** windows are windows which open or "**pop-up**" when a display button is actuated, for example, button 46 on GUI 351 shown in FIG. 4a. The **pop-up** window opened when button 46 is actuated displays a calendar, for example, to assist the user in entering information in the requested ship date box of the electronic purchase order. Further, in keeping with the instant editing functionality of electronic forms application 35, the calendar displayed in response to actuating button 46 may display days on which shipment is available differently from days on which shipment is not available. For example, if a shipper does not ship on Saturdays and Sundays, those days may be blacked out on the calendar displayed. **Pop-up** windows are also useful for other controls, for example, time controls. Time control windows operate similarly to calendar windows by displaying, for example a clock face with the present time. Further, time control windows may operate in conjunction with calendar windows. For example, the hours of operation of a particular business on a particular date (chosen through use of a calendar window) may be displayed on a clock face differently than the hours which that particular business is closed on that particular day. - (Col. 13, l. 52 - Col. 14, l. 12)

b) Applicant's admission "that the term 'pop-up window' was 'notoriously well known' at the time of this parent application's filing date' means that the ordinary practitioner at the time of Applicant's invention would have known that pop-windows could be used with all kinds of triggers. This would surely include the circumstance of "opening a pop-up window for the customer; wherein the receiving transaction information step triggers the opening the equivalent of a pop-up window step". Common sense would have told the practitioner that this notoriously well known device or technique would make for an efficient and effective automated method for conveying transaction information to a customer.

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Appellant's invention to have combined the disclosure of Wilf, Paltenghe, Stein, Daniels, Matyas and AAPA to establish an automated purchasing method for authorizing an online purchase between a customer and a vendor site which includes efficient automated web based steps and user conveniences for validating the payment for an online transaction without exposing the customer's personal information by maintaining security, motivated by a desire to overcome the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claim 2, as discussed in the rejection of claim 1 above, Wilf discloses a method wherein the equivalent of a pop-up window points away from the vendor site by pointing to the transaction server (Col. 2, lines 26-34).

Re. Claim 3, Wilf and Stein disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site comprising a step of receiving account information from the customer corresponding to an account authorized for the debit (Wilf, Col. 2, lines 34-47. See claim 1 re. the debit).

Re. Claim 4, Wilf, Daniels, Matyas and AAPA disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the equivalent of a pop-up window (i.e. the automatic browser window per the rejection of claim 1 above) overlays an existing web browser window of the vendor site (Wilf, Col. 2, lines 3-5, 47-51).

Re. Claims 5, Wilf, Daniels, Matyas and AAPA disclose a method for authorizing and checking out from an online purchase between the customer and the vendor site wherein the receiving transaction information step triggers the opening the equivalent of a pop-up window step (Wilf, Col. 2, lines 3-15. See claim 1 above re. pop-up window.).

Re. Claims 6, 14 & 20, Wilf discloses the method for authorizing and checking out from an online purchase between the customer and the vendor site further comprising a step of transferring payment to an account associated with the vendor site after authorization is received (Col. 7, lines 45-57).

Re. Claim 7, Wilf, Daniels, Matyas and AAPA disclose a step of presenting a message to the customer in the equivalent of a pop-up window indicating at least one of the following: that authorization was canceled by the customer; that authorization was rejected by a funds transfer system; and that authorization completed normally (Wilf, Col. 7, line 58 - Col. 9, line 20. See claim 1 above re. pop-up window).

Re. Claim 9, Wilf discloses a computer-readable medium having computer-executable instructions for performing the computer-implementable method for authorizing and checking out from an online purchase between the customer and the vendor site of claim 1 (Col. 1, line 63- Col. 2, line 3).

Re. Claim 10, Wilf, Stein, Daniels, Matyas and AAPA disclose a method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

- at a funds transfer system, receiving transaction information from the merchant system, wherein the transaction information includes a transaction amount and wherein the funds transfer system is located at a network location away from the merchant system (See the rejection of claim 1);
- opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system (See the rejection of claim 1);

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- from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount (See the rejection of claim 1).
- receiving authorization from the customer for the transaction amount, wherein the transaction amount corresponds to the online purchase (Wilf, Col. 2, lines 3-15, 52 – Col. 3, line 12); and
- notifying the merchant system of authorization (Wilf, Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase.

However, Stein discloses the use of a debit for making payment for a transaction performed over the internet as payment for the internet purchase's transaction amount (Col. 10, l. 51).

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of Wilf, Stein, Daniels, Matyas and AAPA to establish an automated purchasing method for checking-out from an online purchase by a customer from a merchant system which includes efficient automated web based steps and user conveniences for validating the payment for an online transaction without exposing the customer's personal information by maintaining security, motivated by a desire to overcome the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claim 11, Wilf and Stein disclose a step of receiving account information from the customer corresponding to an account available for debits by the funds transfer system (Wilf, Col. 2, lines 34-47. See claim 1 re. the debit).

Re. Claim 12, Wilf, Daniels, Matyas and AAPA disclose a method wherein the pop-up window overlays an existing web browser window of a web site associated with the merchant system (The a pop-up window implicitly overlays the existing web browser window being viewed).

Re. Claim 14, Wilf discloses a comprising a step of transferring payment to an account

associated with the merchant system after authorization is received (Col. 2, ll. 14-15).

Re. Claim 15, Wilf discloses a method comprising a step of presenting a message to the customer in another window indicating at least one of the following: that authorization was canceled by the customer; that authorization was rejected by the funds transfer system; and that authorization completed normally. (Col. 7, line 58 - Col. 9, line 20.).

Re. Claim 17, Wilf discloses a method for checking-out from an online purchase by a customer from a merchant system, the method comprising steps of:

- at a funds transfer system that is located at a network location away from the merchant system, receiving account information from the customer (Col. 1, l. 61 – Col. 2, l. 51. See the rejection of claim 1. Further, the funds transfer system is obviously at a location away from the merchant system connected by the world wide web (col. 1, ll. 5-24, 44-49; col. 1, l. 61-col. 2, 3);
- from the funds transfer system, interacting with the pop-up window to present a transaction amount in the pop-up window and receive customer assent to the transaction amount (see the rejection of claim 1);
- receiving authorization from the customer for the transaction amount, wherein the transaction amount corresponds to the online purchase (Col. 2, ll. 32-47); and
- notifying the merchant system of authorization (Col. 2, lines 3-15, 52 – Col. 3, line 12).

Wilf does not explicitly disclose

- receiving account information from the customer corresponding to an account available for debits by the funds transfer system;
- receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase.
- opening a pop-up window that is viewable by the customer, wherein the pop-up window is formulated by the funds transfer system (col. 2, ll. 3-51 - see the rejection of claim 1);

However, Stein discloses the use of a debit for making payment for a transaction performed over the internet (Col. 10, l. 51). This implicitly includes receiving account information from the customer corresponding to an account available for debits by the funds transfer system; and receiving authorization from the customer of a debit for the transaction amount, wherein the debit corresponds to the online purchase.

Daniels and Matyas disclose the use of pop-up windows (see the rejection of claim 1). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the art of Wilf, Stein, Daniels, Matyas and AAPA with well known art to establish an automated purchasing method which includes efficient automated web based steps and user conveniences for validating the payment for an online transaction without exposing the customer's personal information by maintaining security, motivated by a desire to overcome the reluctance of some users to transmit credit card account information over the internet (Wilf, Col. 1, ll. 24-27).

Re. Claim 18, Wilf, Daniels and Matyas and AAPA disclose a method wherein the account information is received through the pop-up window (Wilf, Col. 2, lines 3-15. See claim 1 above re. pop-up window.).

Re. Claim 19, Wilf discloses a method comprising a step of receiving transaction information from the merchant system (Col. 2, lines 3-15.).

Re. Claim 20, Wilf discloses method of transferring payment to an account associated with the merchant system after authorization is received (Col. 2, lines 3-15; Col. 7, lines 45-57).

4. Claims 8 & 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilf, Stein, Fung and AAPA in view of Kolling et al (US Patent 5,920,847, hereafter Kolling).

Re. Claims 8 & 16, none of Wilf, Stein, Daniels, Matyas and AAPA explicitly disclose a method for authorizing and checking out from an online purchase between the customer and the vendor, wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period. However, Kolling discloses a method for authorizing and checking out from an

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online purchase between the customer and the vendor site wherein the notifying step comprises a step of determining that a notification message was not received by the vendor site within a predetermined time period (Col. 37, lines 2-8). It would have been obvious for an ordinary practitioner of the art at the time of applicant's invention to have combined the disclosure of Wilf, Stein, Daniels, Matyas and AAPA with the disclosure of Kolling to establish an automated purchasing method which included a time limit for notifying a vendor of payment approval for an automated transaction in order to protect a vendor from undue delay in verifying such a transaction while minimizing costs, maintaining certain controls and discretionary actions on behalf of the biller, and simplifying the process for all the parties (Kolling, Col. 10, ll. 25-62).

Response to Arguments

5. Applicant's Remarks filed June 30, 2010 with respect to claims 1-12 and 14-20 only contain factual statements regarding prosecution history and do not present arguments regarding the patentability of the pending claims, making moot a response to arguments by the examiner.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Alexander Kalinowski, can be reached on (571) 272-6771.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

Art Unit 3695
August 14, 2010

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 3695